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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,649	11/07/2001	Nobuyoshi Morimoto	5596-00901	9861

7590 02/22/2010

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ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
02/22/2010	PAPER

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The time period for reply, if any, is set in the attached communication.

Advisory Action

Claim 1

1. The Applicant argues the cited references, whether considered singly or in combination fail to teach the generation of the *specific* type of data file of claim 1 and the storing of that *specific* data file in a memory device that accompanies the item during said shipment. The Applicant argues more specifically, at no point does Harrell (even when considered with Pipinsure and Keuper) teach or suggest "generating a data file comprising at least the following: item information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance," much less "storing the data file [that comprises both the item information and the insurer information] in a memory device that accompanies the item during said shipment." The Applicant further adds such a data file is not present within the teachings of the cited art. Simply because Figure 1 of Harrell recites the phrase "stored data" does not mean that the cited art teaches a specific type of data file that includes both a specific type of item information and a specific type of insurer information as claimed. The Examiner respectfully disagrees.

With regard to *generating a data file*, Harrell discloses completing data entry requirements and downloading a customer profile (Table 1 and paragraph 126). It is suggested that downloading a customer profile will generate a data file containing customer information. The *item information including one or more characteristics of the item*, as claimed by the Applicant, is shown where the data is input regarding the commodity (i.e. item); Table 9 of Harrell discloses that the information would include the type of commodity to be shipped and characteristics (i.e. is the item to be containerized). The *insurer information indicating one or more terms of said particular insurance* is disclosed where Harrell teaches a system is which a quote is displayed containing quote information such as premium, deductible, currency, terms, and conditions (Figure 2). The terms and conditions of the contract (i.e. insurance) are provided to the user for review (paragraph 48). The limitation store the data file in the memory device that accompanies the item during said shipment is disclosed by Harrell. Harrell discloses a method and system in which a quote calculation is saved so it is available for the next time a user logs in (Tables 2

and 9). Thus it is suggested that the data file generated, containing a user profile, is saved demonstrating a memory device.

With regard to the Applicant's assertion that "*In fact, such a data file is not present within the teachings of the cited art. Simply because Figure 1 of Harrell recites the phrase "stored data" does not mean the cited art teaches a specific type of data file that includes both a specific type of item information and a specific type of insurer information*", the Examiner respectfully submits Harrell discloses a method and system where a data file is generated, containing a user profile, and is saved for future uses. Harrell was not relied upon for a memory device which accompanies an item during shipment. This feature was disclosed by Keuper (page 3, lines 1 – 8) where Keuper discloses attaching in or on a barrel (i.e. the item to be shipped) a transponder which is in communication with a transmission/receiving device for data transfer. Although the information on the transponder is not related to insurance, or an insurance provider, it would be obvious to include the electronic insurance information as the process of transferring the data to the memory device on the item to be shipped would be the same, regardless of the information. Thus, Applicant's argument is not persuasive.

2. The Applicant argues the cited art fails to teach or suggest searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for an item during said shipment. The Examiner respectfully disagrees. Pipinsure provides a user the ability to enter shipping needs, value of items to be shipped and coverage desired (pages 8 and 10) all of which suggest a particular insurance for shipment of an item. In addition, Pipinsure utilizes a broker for handling policy changes (page 23) suggesting the availability of different policies.

3. The Applicant argues the Examiner has failed to provide a proper reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of Keuper with the teaching of Harrell and Pipinsure. The Examiner respectfully disagrees.

Harrell is directed to a method and system for, but not limited to, individual shipment insurance policy purchase, customer pre-qualification, quote creation, billing, insurance certificate issuance and

voidance, risk and reinsurance evaluation, shipment detail data entry, data validation, reinsurance, premium calculation, and claims using a computer system (paragraphs 91 - 108 and Table 1).

Pipinsure is directed to a system for purchasing package insurance for shipments (page 2). The user enters information, such as average value per package and highest insured value for any one package; to receive a quote on package insurance needs (page 8).

Keuper is directed to a process for acquiring electronic information of an item (in this case a beer barrel) being shipped (or transported) where a transponder is attached to the item (i.e. beer barrel) and is in active connection with a transmission/receiving device for the purpose of data transfer (page 3, lines 1 - 8).

It would have been obvious to one of ordinary skill in the art to include method and system of individual shipment insurance policy purchase of Harrell and a method and system of purchasing package insurance for shipments of Pipinsure in the method and system for acquiring and transferring electronic information of an item being shipped (or transported) as taught by Keuper since the claimed elements are merely a combination of old elements and in the combination, each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

4. The Applicant argues Keuper is non-analogous art. It has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Firstly, the Examiner respectfully submits that the prior art references are in the field of Applicant's endeavor. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant's invention pertains to a System and Method for Arranging Shipment and Insurance for an Item.

. The Examiner respectfully submits in this case that the primary reference, [Harrell (U.S. Publication Number 2002/0156656) is a method and system directed to individual shipment insurance policy purchase; PipInsure (http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html) is directed to a

system for purchasing package insurance for shipments; Keuper (DE 44 46203 A1) is directed to acquiring and transferring electronic information of an item being shipped (or transported)]. Thus, it is the position of the Examiner that [Harrell, Pipinsure, and Keuper] are in the field of the Applicant's endeavor (i.e., they relate to a system and method for Arranging Shipment and Insurance for an Item) and are therefore analogous art.

Secondly, the Examiner respectfully submits that the prior art references are reasonably pertinent to the particular problem with which the Applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Keuper is directed to solving the problem of attaching an electronic memory device to an item to be shipped which communicates with a transceiver. The present application also seeks to solve a similar problem, namely, attaching an electronic memory device to an item to be shipped. Thus, it is the position of the Examiner that the prior art references are reasonably pertinent to the particular problem with which the Applicant was concerned and the applied references are analogous art as they all relate to attaching information to an item to be shipped using an electronic memory device.

5. The Applicant argues the Harrell reference has not been shown to be prior art to the present application. The Applicant adds, under 35 USC 119(e)(1) a published utility application is not entitled to its provisional application's filing data as a prior art data unless at least one claim of the published utility application is supported (per 35 USC 112) in the provisional application. The Examiner did not address the requirement for a claim of the published utility application to be supported (per 35 USC 112) in the provisional application. The Examiner respectfully disagrees and submits claim 1 of the non-provisional application is supported by the following pages and paragraphs of the provisional application of Harrell.

Page 2, paragraphs 2 – 12 where Harrell discloses the underwriting process composed of quote creation, billing, certificate issuance, reinsurance and loss control.

Page 3, paragraph 1 where Harrell discloses reinsurance.

Page 5, paragraphs 1 – 5 where Harrell discloses the claims process.

Thus, Applicant's argument is not persuasive.

6. The Applicant argues the Pipinsure reference has not been shown to be prior art to the present application. The Applicant adds http://www.archive.org does not guarantee the accuracy of its

collections, Applicant asserts that it is not proper to rely on http://www.archive.org to establish a publication date. The Examiner respectfully disagrees. The Examiner submits http://www.archive.org collects information from various web sites; the actual website is responsible for the accuracy of the content; http://www.archive.org merely provides a link to the Pipinsure website, it does not provide the content. In addition, MPEP section 2128, Electronic Publications as Prior Art states

> **Status as a Printed Publication**
> An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 95 (CCPA 1981) ("Accordingly, whether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form it may be, as a printed publication' * * * should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.'" (citations omitted).). See also *Amazon.com v. Barnesandnoble.com*, 73 F. Supp. 2d 1228, 53 USPQ2d 1115, 1119 (W.D. Wash. 1999) (Pages from a website were relied on by defendants as an anticipatory reference (to no avail), however status of the reference as prior art was not challenged.); *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (Database printouts of abstracts which were not themselves prior art publications were properly relied as providing evidence that the software products referenced therein were "first installed" or "released" more than one year prior to applicant's filing date.).
>
> The Office policy requiring recordation of the field of search and search results (see MPEP § 719.05) weighs in favor of finding that Internet and on-line database references cited by the examiner are "accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents." *Wyer*, 655 F.2d at 221, 210 USPQ at 790. Office copies of an electronic document must be retained if the same document may not be available for retrieval in the future. This is especially important for sources such as the Internet and online databases.
>
> **Date of Availability**
> Prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. *>Absent evidence of the date that the disclosure was publicly posted, if< the publication >itself< does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b)*>. However<, it may be relied upon to provide evidence regarding the state of the art. Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication >or posting<. See MPEP § 901.06(a), paragraph IV. G.

Thus, Applicant's argument is not persuasive.

Claims 19 and 20

The Applicant argues the Examiner failed to state a prima facie rejection of claims 19 and 20 because the office action failed to address specific limitations of claims 19 and 20. The Examiner

respectfully disagrees and submits Pipinsure provides a data field in which a user may input the highest insured value of any package when requesting a quote for package insurance (page 8), thus the highest insured value is equated to a maximum coverage. Therefore, Applicant's argument is not persuasive.

Claim 7

The Applicant argues the cited art fails to teach or suggest shipping the item using the least expensive routing. The Examiner respectfully submits that Harrell teaches a method where modifications can determine the least expensive premium (Figure 2); the Examiner submits that typically the least expensive premium offers the least amount of coverage, therefore, the least amount of coverage would equate to the least expensive shipping method.

Claim 8

The Applicant argues the cited art fails to teach or suggest wherein the data file further comprises contact information for at least one insurance company that will provide said insurance. The Examiner respectfully disagrees and submits Harrell teaches a method a reinsurer is notified in Figure 12, thus it is reasonable to conclude that the reinsurers contact information is available. In addition, Figure 14 illustrates contact of a claims representative and underwriter. Thus, Applicant's argument is not persuasive.

Claim 18

7. The Applicant argues the cited art fails to teach or suggest wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file and Keplar's air contaminant detection device is separate from and does not accompany Keplar's shipping container The Examiner respectfully disagrees. It would be obvious to include the air testing device of Keplar with the method of Harrell, Pipinsure, and Keuper. Harrell discloses a method and system directed to individual shipment insurance policy purchase; PipInsure is directed to a system for purchasing package insurance for shipments; and, Keuper is directed to acquiring and transferring

electronic information of an item being shipped (or transported). Thus, attaching the air testing device to the memory device attached to the item to be shipped would be predictable.

8. The Applicant argues the Examiner has not provided a proper reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of Keplar with the other cited references. The Examiner respectfully disagrees.

Harrell is directed to a method and system for, but not limited to, individual shipment insurance policy purchase, customer pre-qualification, quote creation, billing, insurance certificate issuance and voidance, risk and reinsurance evaluation, shipment detail data entry, data validation, reinsurance, premium calculation, and claims using a computer system (paragraphs 91 - 108 and Table 1).

Pipinsure is directed to a system for purchasing package insurance for shipments (page 2). The user enters information, such as average value per package and highest insured value for any one package, to receive a quote on package insurance needs (page 8).

Keuper is directed to a process for acquiring electronic information of an item (in this case a beer barrel) being shipped (or transported) where a transponder is attached to the item (i.e. beer barrel) and is in active connection with a transmission/receiving device for the purpose of data transfer (page 3, lines 1 - 8).

Kepler is directed to a system for sampling air in appliance shipping container (abstract).

It would have been obvious to one of ordinary skill in the art to include method and system of individual shipment insurance policy purchase of Harrell and a method; system of purchasing package insurance for shipments of Pipinsure; and the method and system for acquiring and transferring electronic information of an item being shipped (or transported) of Keuper in the system for sampling air in an appliance shipping container as taught by Kepler since the claimed elements are merely a combination of old elements and in the combination, each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

/Robert Morgan/
Primary Examiner, Art Unit 3626